

REMARKS

Reconsideration and allowance are respectfully requested.

Newly added claims 57-76 are similar in scope to cancelled claims 37-56 and particularly point out and distinctly claim the subject matter of the invention. No new matter has been added. Entry and allowance are requested.

The examiner relies on Yasutake in the rejection of the dependent claims. Yasutake is not of record because the references has neither been cited on form PTO-892 nor on Applicant's IDS form 1449. However, Applicant has relied on the patent number provided by the Examiner (page 3 of the office action) to rebut the obviousness rejection.

Claims 57-76 are patentable under 35 U.S.C. 103(a) over Horton (US 6,452,585) in view of Swan (US 6,351,222). Claims 57-76 are also patentable under 35 U.S.C. 103(a) over Horton, Swan and Yasutake (US 6,597,347).

Horton relates to a device and method for tracking moving objects not in direct physical contact with the system and displaying a virtual image of the object by transmitting data from the object spaced apart from the system. Horton relates to a device that is not even remotely connected to the claimed invention because the invention expressly requires frictional surface interaction. Thus, nothing in Horton describes, teaches, or suggests the claimed features.

The courts have held, when the prior art contains apparently conflicting references, [the Board] must weigh each reference for

its power to suggest solutions to an artisan of ordinary skill. In weighing the suggestive power of each reference, [the Board] must consider the degree to which one reference might discredit another. In re Young, 18 USPQ2d 1089, 1091 (CAFC, 1991).

Swan relates to a device for inputting commands, such as acoustics and/or gesture commands, to an entertainment device. However, that has nothing to do with the claimed invention which detects the location of contact by generating random sound by the frictional interaction of the fingertip on the surface.

Moreover, with Horton having nothing to do with the claimed invention, the combined teachings of Horton and Swan will lead further away from the present claims. Therefore, Horton and Swan do not, and cannot, teach, suggest or by inherency render any of the present claims obvious.

In deciding that a novel combination would have been obvious, there must be supporting teaching in the prior art. There is no suggestion or motivation in the prior art to combine the elements as done by the present invention and hence the claims cannot be rendered obvious. In re Newell, 13 USPQ2d 1248, 1250 (CAFC, 1989).

Yasutake relates to a device having first and second surfaces coupled to first and second transducers respectively, in which the first and second surfaces are pressure sensitive surfaces for detecting pressure forces.

As pointed out above, Horton and Swan teach away from the present claims. Therefore, any further combination with tertiary

references, such as Yasutake, will also lead away from the claimed invention.

That [the prior art] might incorporate elements which could be used in appellants' system does not render appellants' claims obvious when there is no suggestion of using these elements in substantially the same manner as appellants use them. In re Donovan, 184 USPQ 414, 421 (CCPA, 1975).

The invention generally relates to an apparatus and a method for determining the location of contact between a moving fingertip and a surface across which it is moving by generating random sound at the location of the contact by a process of substantially continuous frictional interaction between the surface and the moving fingertip. Sound waves are conducted from the location of the interaction to at least one microphone via sound-conducting material. Signals from the at least one microphone are analyzed and results of the analysis are processed for identifying the location of contact. Nothing in the references describe, teach or suggest those claimed features defined in claims 57, 66, and 67.

Dependent claims 58-65 and 68-76 add further unique features to claims 57 and 67, respectively, and are also patentable over Horton, Swan and Yasutake.

Nothing in the references, either singly or in combination, teaches or suggests the claimed features. Therefore, the references cannot anticipate nor render obvious the present invention as claimed.

Since Applicant has presented a novel, unique and non-obvious invention, reconsideration and allowance are respectfully requested.

Respectfully,

A handwritten signature in dark ink, appearing to read "J. C. Wray", is written over the typed name.

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